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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/780,313
Filing Date: February 17, 2004
Appellant(s): OPPERMAN ET AL.

Nathaniel Levin (Reg. No. 34,860)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/15/08 appealing from the Office action
mailed 3/18/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: **Claims 20-23** are rejected under 35 U.S.C. § 101.

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20-23 are rejected under 35 U.S.C. § 101 based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process must (1) be tied to

another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. FLook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876). The process steps in **claims (20-23)** are not tied to another statutory class nor do they execute a transformation. Thus, they are non-statutory.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20020038278	Himmelstein	3-2002
2004068458	Russo	4-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Status of claims:

Claims **1-19** and **24-37** are cancelled.

Claims **20-23** are pending.

Note: Claim Rejections - 35 USC § 101 (New Ground of Rejection) see item 6 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20 - 23 are rejected under 35 U.S.C. 103 (a) as being unpatentable over *Himmelstein* (2002/0038278) in views of *Russo* (2004/068458).

As per claim 20, *Himmelstein* discloses a method comprising:

displaying a first order type menu at times when a first order destination alternative is selected from an order destination menu, (**para 0050-052**; via barter website **106** or pull down menus **507** and also **para 0147** inherently destination at NYSE and the NASDAQ market) the first order destination alternative representing a first order destination, the first order type menu listing only order type alternatives that represent order types supported by the first order destination; and

displaying a second order type menu at times when a second order destination alternative is selected from the order destination menu, second order destination alternative representing a second order destination, the second order type menu listing only order type alternatives that represent order types supported by the second order destination, the second order type menu being different from the first order type menu (**para 0052**, lines 12; via an array of pull down menus **507** for selection of second order type menu different from first type);

Himmelstein fails explicitly to disclose that the first order destination and the second order destination are each selected from the group consisting of (a) securities exchange, (b) a market maker,(c) an ECN, and (d) a trading market placer; and order type alternatives included in both said and second order type menus include a market order type and a limit order type.

However, **Russo** being in the same field of invention discloses that the first order destination and the second order destination are each selected from the group consisting of (a) securities exchange, (b) a market maker,(c) an ECN, and (d) a trading market placer; and order type alternatives included in both said and second order type menus include a market order type and a limit order type (**Abstract** and **Figs 1-108** , para **0001-0003** - via viewing screen window with user's of the machine's interface; para **0010** - via a logic field- provision of two choices; para **0240**-via choosing another symbol of exchange [**Fig-057**] as destination ; para **0233** and **0241** – via a limit order trade [type] and trade per share price [market order type] respectively).

Therefore , it would have been obvious to an ordinary skill in the art at the time of invention was made to modify the disclosure of **Himmelstein** and include the features mentioned by **Russo** to facilitate the user of the **machine-1** Dissemination Center then immediately signals ... The user ... of NYSE listed **CMGI** stock ... wait for the profits and or ships to come in (**para-0234**)

As per claim 21, **Himmelstein** discloses a method comprising:

displaying a first order destination menu at times when a first financial instrument trading symbol is displayed in an order input area of a user interface (**para 0050-0052**; via barter website **106** or pull down menus **507** and also **para 00147** inherently destination at NYSE and the NASDAQ market. First instrument trading symbol **Aetna Stock-AET** at line 21 of **para 0041**), the first order destination menu listing only order destination alternatives that correspond to order destinations that support trading in a first financial instrument that correspond to the first financial instrument trading symbol; and

displaying a second order destination menu at times when a second financial instrument trading symbol is displayed in the order input area, second order destination alternative representing a second order destination, the second order type menu listing only order type alternatives that represent order types supported by the second odder destination, the second order type menu being different from the first order type menu, the second order destination menu being different from the first order destination men (**para 0052**, lines 12; via an array of pull down menus **507** for selection of second order type menu different from first type. Second Instrument trading Symbol - the DuPont Option **DD** also in **Fig.5A**).

Himmelstein fails explicitly to disclose that at least one of the order destination alternatives listed by the first order destination menu is different from each order destination alternative listed by the second order destination menu; and each of the order destinations is selected from the group consisting of (a) a securities, (b) a market maker, (c) an ECN and (d) a trading market place.

However, **Russo** being in the same field of invention discloses that at least one of the order destination alternatives listed by the first order destination menu is different from each order destination alternative listed by the second order destination menu; and each of the order destinations is selected from the group consisting of (a) a securities, (b) a market maker, (c) an ECN and (d) a trading market place (**Abstract** and **Figs 1-108**, para **0001-0003** - via viewing screen window with user's of the machine's interface; para **0010** - via a logic field- provision of two choices; para **0240**-via choosing another symbol of exchange [**Fig-057**] as destination ; para **0233** and **0241** – via a limit order trade [type] and trade per share price [market order type] respectively).

Therefore, it would have been obvious to an ordinary skill in the art at the time of invention was made to modify the disclosure of **Himmelstein** and include the features mentioned by **Russo** to facilitate the user of the **machine-1** Dissemination Center then immediately signals ... The user ... of **NYSE** listed **CMGI** stock ... wait for the profits and or ships to come in (**para-0234**).

As per claim 22, **Himmelstein** discloses that the first financial instrument trading symbol represents a first common stock (**para 0041**, line 21; via **Aetna** Stock symbol-**AET**, **234**); and the second financial instrument trading symbol represents a second common stock (**para 0041**, line 19; via **DuPont** Stock-**DD**, **228**).

As per claim 23, **Himmelstein** discloses that the first financial instrument trading symbol represents a common stock (**para 0041** line 21; via **Aetna** Stock symbol-**AET**,

234); and the second financial instrument trading symbol represents an option (para 0051, line 12; via the DuPont Option-DD).

(10) Response to Argument

1. In response to **applicant's** argument (**page 7**, last two lines) that "As far as appellants can determine, **Himmelstein** fails to disclose either order type menus or order destination menus as recited in the claims at issue herein", **The Examiner** refers **Himmelstein** disclosing clearly the order type menus (understood for sell, buy or hold transactions) by (see **para 0049**, lines 1+) "the system **100** in its most generalized configuration permits barterers of different securities, financial interests, ... Hammerstein Option".

In **para 0054**, line 1+ "In the example of **Figs. 4** and **5**, barter website **106** is accessed via an online stock trading company ... In step **404**, the barterer selects from the displayed items in step **402**. In the embodiment of Fig. **5A**, (**para 0051**, line 1+) a symbol **502** representing a selection ... the **DuPont Option DD** is depicted ... closing date".

In **para 0052**, line 4+ "Optionally, an alphabetical list of companies and /or stock symbols ... also displayed. The barter may enter the selected item **502** by typing ... name or symbol of the company, the barter ordering module locates the first listed item that matches the entered characters. Alternatively, the portfolio is deployed for selection via an array of **PULL DOWN menus 507**, each displaying one class of the items of the barter's portfolio".

In **para 0053**, line 1+ "Once the barterer locates and selects the item to be traded", and "once the order (**para 0100**, line 1+) is submitted ... the matching engine searches website database" and in **para 0103**, lines 1+ "if the individual decides ... to

barter away selected portfolio stock ... and when a posted order is chosen, the system **100** enters ... notify the individual of the transaction ..."shares trading away" as reflected in screen table **620** of **Fig.6.**"

2. In response to **applicant's** further arguments (**page 8**, first para) that "The Russo reference ...appear to be selecting a symbol that represents a particular security, and selecting between either a market order type or limit order type ... Reference lacks disclosure of any order destination menu as recited in the claims now being appealed", as a secondary reference **Russo** clearly discloses first and second order destinations and order type menus with the additional features to make it obvious in the reference. In **para 0219-0228** with **Figs. 039-060** , it is clear to get the steps of operation with window **4G** showing all order destination selections for **NYSE** (stock symbol – **CMGI**), **NASDAQ** (**OXHP**) & **AMEX** (**ADVANA**) **Exchanges**. Next (**para 0229**) "user" of the machine has three options, such as Monitoring, Limit order and Trading. So trading without limit order type – a market order trading (implied). Hence, it is clear with monitoring, then selection and trading in **Russo's** additional features mentioned in different steps of operations as **Menus** in Window **4G**.

3. In response to **appellant's** further arguments (**page 8**, second para) that, "the **Russo** reference does not explicitly show even one order type menu, but it appears ...it does not appear to teach the two different order type menus called for by claim 20", here **Russo** is referred again for his clear disclosures of limit or market order type menus (understood for sell, buy or hold transactions) in **Figs 61-84**, depicting

specifically in **Fig. 073** (sell @ 17.00), **Fig.080** (buy [100] shares of ADVNA), **Fig 084** (Trading complete) and also more transactions in **Figs. 091-096**.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR

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41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Hatem Ali/

Examiner, Art Unit 3692

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/

Director, TC 3600

Conferees:

Kambiz Abdi /K. A./

Supervisory Patent Examiner, Art Unit 3692

Vincent Millin /VM/

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Appeals Conference Specialist